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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/432,087	11/02/1999	TAKESHI MISAWA	0879-0242P	9612

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BIRCH STEWART KOLASCH & BIRCH LLP  
P O BOX 747  
FALLS CHURCH, VA 220400747

EXAMINER

VORTMAN, ANATOLY

ART UNIT	PAPER NUMBER
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2835

21

DATE MAILED: 03/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/432,087

Applicant(s)

MISAWA, TAKESHI

Examiner

Anatoly Vortman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 January 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-23 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Amendments*

1. By amendment filed on 01/23/03 the Applicant has amended claim 17. Claims 1-23 are pending in the instant application.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1-7, 9, 11, and 18-23, are rejected under 35 U.S.C. 102(e) as being anticipated by US/5,880,928 to Ma.

Regarding claims 1 and 13, Ma disclosed (Fig. 1 and 2), a personal computer comprising: a base unit (1); an input part (keyboard) arranged on the base unit, the input part having an operational face (a top side of the keyboard); a display unit (2) having a display face (a front side of the display), the display unit being operatively interconnected to the base unit (1) in a state that the display face forms an angle less than 180° with the operational face when the personal computer is in use (the display unit is rotatable and may be positioned at any desirable

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angle); and a chamber for accepting an external device (222 or 212) enhancing a function of the personal computer, the chamber being arranged in (within) the display unit (2).

Regarding the functional recitation that the chamber is *capable or adapted of interchangeably accepting and external device*, please note that it has been held that the aforementioned functional recitations have not been given patentable weight because they are narrative in form. In order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function, as set forth in 35 USC § 112, 6th paragraph, or must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

Regarding claims 2 and 3, Ma disclosed that said display unit (2) is capable of closing the display face and the operation face when the personal computer is not in use, (Fig. 1).

Regarding claims 4 and 5, Ma disclosed that said display unit (2) is hinged and rigidly joined to the base unit (1) in the state that the display face forms the angle less than 180° with the operational face, (Fig. 1).

Regarding claim 6, Ma disclosed that the chamber opens (22) at topside of the display unit (2), (Fig. 1).

Regarding claim 7, Ma disclosed that chamber opens (21) at a lateral side of the display unit (2), (Fig. 1).

Regarding claim 9, Ma disclosed a keyboard, (Fig. 2).

Regarding claim 11, Ma disclosed a camera (222).

Regarding claim 15, Ma disclosed (Fig. 1 and 2), an apparatus for interfacing a computer with an external device (222 or 212), the apparatus comprising: a display unit (2)

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having a display face (a front side of the display) and being movably coupled to a base unit such that the display face forms an angle generally less than 180° with the base unit (the display unit is rotatable and may be positioned at any desirable angle); and a chamber having a predetermined depth, the chamber disposed in the display unit (2), the chamber having an electrical connection (connecting wires positioned at the bottom of the chambers as shown on Fig. 1) in an innermost recess thereof, the chamber configured to accept at least a portion of the external device (222 or 212) such that an electrical connection can be established between the computer and the external device (Fig. 1).

Regarding the recitation that the *chamber configured to interchangeably accept at least a portion of the external device*, the aforementioned functional recitation has not been given patentable weight because it is narrative in form. In order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function, as set forth in 35 USC § 112, 6th paragraph, or must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

Regarding claim 16, Ma disclosed, (Fig. 1 and 2), an apparatus for interfacing a computer with an external device (212 or 222), the apparatus comprising: a display unit (2) having a display face (a front side of the display) and being movably coupled to a base unit such that the display face forms an angle generally less than 180° with the base unit (the display unit is rotatable and may be positioned at any desirable angle); and a chamber formed inside the display unit (2), the chamber having walls capable of covering the bottom side, a left and right side, and a front and back side of the external device (212 or 222), the chamber having an opening

disposed on the outside of the display unit (21 or 22) configured to receive the external device (212 or 222), (Fig. 1).

Regarding the recitation that the display unit *configured to adaptably receive the external device*, the aforementioned functional recitation has not been given patentable weight because it is narrative in form. In order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function, as set forth in 35 USC § 112, 6th paragraph, or must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

Regarding claim 14 the method steps recited in the claim are inherently necessitated by the device structure as it is disclosed by Ma.

Regarding claims 18-22, Ma disclosed that said external device (212 or 222) is removable (Fig. 2-4).

4. Claims 17 and 23 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by US/5786983 to Brenner et al.. (Brenner).

Regarding claims 17 (as amended) and 23, Brenner disclosed a computer structure (Fig. 1 and 7) which inherently necessitates the method steps recited in the claims, including: forming a chamber (146) inside a display unit (102) coupled to the computer, the display unit (102) having a display face (122) and being movably coupled (via cord (113)) to a base unit (112) such that the display face (122) forms an angle generally less than 180° with the base unit (112), and the chamber having walls (inherently) for covering a bottom side, a right side, and a front and back side of the removable external device (116), wherein the chamber (146) is configured to

interchangeably receive the external device (116); and forming an opening associated with the chamber such that only the opening of the chamber is disposed on the outside of the display unit (102).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ma in view of US/5,768,163 to Smith, II (Smith).

Ma disclosed all of the claim limitations as apply to claim 1, but did not disclose that said external device is a wireless communication device.

Smith disclosed (Fig. 15) an external device (82) for portable computer, said external device (82) comprising a wireless communication device (84).

Since the invention of Ma and Smith are from the same field of endeavor (portable computers), the purpose of said wireless communication device disclosed by Smith would be recognized in the invention of Ma.

It would have been obvious to a person of ordinary skill in the portable computer art at the time the invention was made to use the wireless communication device as taught by Smith

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instead of said external device (212 or 222) in the portable computer of Ma, in order to provide said portable computer of Ma with remote control capabilities (Smith, column 6, lines 6+).

### ***Allowable Subject Matter***

7. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Smith failed to disclose a cutout part and a transparent part positioned so, that when the external device inserted in the chamber, it would have been visible through said transparent part.

### ***Response to Arguments***

8. Applicant's arguments provided in the reply filed on 01/23/03 are not persuasive.

The main thrust of the Applicant's arguments regarding claims 1 and 13-16 is directed to the assertion that the Examiner is in error by not giving patentable weight to the functional recitations of the claims. In support for this assertion, the Applicant has stated that Examiner's interpretation of the *In re Fuller* is incorrect, since "*In re Fuller* predates 35 U.S.C. § 103, six paragraph" (p. 7, lines 2+ of the reply) and that "there is no requirement that functional recitations be written in the means-plus-function form" (p. 6, lines 19, 20).



In response the Examiner would like to clarify his position:

Please, note that functional limitations of the claim is given their broadest reasonable interpretation, in light of and consistent with the written description of the invention in the application only if said functional limitations invoke 35 U.S.C. 112, sixth paragraph.

(See Donaldson, 16 F.3d at 1194, 29 USPQ2d at 1850 (stating that 35 U.S.C. 112, sixth paragraph “merely sets a limit on how broadly the PTO may construe means-plus-function language under the rubric of reasonable interpretation.”)).

A claim limitation will be interpreted to invoke 35 U.S.C. 112, sixth paragraph if it meets the following 3-prong analysis:

- (A) the claim limitations must use the phrase “means for ” or “step for ”;
- (B) the “means for ” or “step for ” must be modified by functional language;
- and
- (C) the phrase “means for ” or “step for ” must not be modified by sufficient structure, material or acts for achieving the specified function.

With respect to the first prong of this analysis, a claim element that does not include the phrase “means for” or “step for” will not be considered to invoke 35 U.S.C. 112, sixth paragraph.(MPEP ¶ 2181). In the instant case, since claims functional limitations do not include the phrase “means for” or “step for” said functional limitations have not been considered to invoke 35 U.S.C. 112, sixth paragraph, i.e. they have not been interpreted by the Examiner in light of and consistent with the written description of the invention in the application.

Furthermore, since claim’s functional limitations in the instant case did not invoke 35 U.S.C. 112, sixth paragraph, the only venue for the Examiner to give the aforementioned

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functional limitations patentable weight would have been to find in the claims a sufficient structure in support of said functional limitations (as decided in *In re Fuller*) which claims failed to provide.

Therefore, the Applicant's remarks regarding the age of *In re Fuller* are believed to be irrelevant, since the Examiner's intention was to point out that since claims functional limitations did not invoke 35 U.S.C. 112, sixth paragraph and did not satisfy *In re Fuller*, those functional limitations have not been given patentable weight.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anatoly Vortman whose telephone number is 703-308-7824. The examiner can normally be reached on 9:30-6:00, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Darren Schuberg can be reached on 703-308-4815. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3431 for regular communications and 703-305-3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.

Anatoly Vortman  
Primary Examiner  
Art Unit 2835

A.V.  
February 28, 2003

A handwritten signature in black ink, appearing to read "A. Vortman", followed by a horizontal line.